

Atty's Docket: Beiersd rf 653-WCG
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It is respectfully suggested that it would be proper for Examiner to enter and consider this amendment because it raises no new issues, and introduces no new matter. The amendment merely adds the subject matter of a dependent claim. In addition, the Applicants believe in good faith that the amendment to claim 1 puts the claims in condition for allowance.

The rejections will be addressed in the sequence in which they appeared in the Final Action.

Finality of the Rejection

Applicants respectfully request that the finality of the rejection be withdrawn because the new grounds of rejection were not necessitated by the previous amendment. PTO guidelines explicitly state that:

[a] second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.

MPEP § 706.07(a).

In this case, the finality of the rejection is based on the Examiner's conclusion that the previous amendment necessitated new grounds of rejection. However, the previous claim amendments merely added the subject matter of dependent claim 7, and addressed the Examiner's requirement for clarifying the macro/micro embossing limitation.

As stated in the MPEP guidelines quoted above, these amendments do support the present rejection being made final as necessitated by the previous amendment.

In accordance with PTO guidelines, these facts militate in favor of withdrawing the finality of the rejection, and such withdrawal is respectfully requested.

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Newly Amended Claim 1 Is Now Believed To Be Free Of The Prior Art

With respect to Masatoshi's disclosure, it is assumed that the embodiment shown in Fig. 2 forms the basis of the instant rejections. This is the only embodiment in which the adhesive is applied to the textile.

Anticipation

Newly amended claim 1 now specifically requires that the first elastic layer comprise (i) two coextruded layers, wherein (ii) the coextruded layers comprise an outer layer and a tie layer.

As Examiner has stated, this limitation is not disclosed in Masatoshi. See office action, page 4, 1st ¶. Therefore, the anticipation is hereby overcome.

Obviousness

Amended claim 1 now requires the first elastic polymer film to comprise a coextruded outer film and tie layers. The latter serves to enhance the contact between the outer film layer and the nonwoven textile sheet layer. This claim limitation is not taught or suggested by the combined references.

Nowhere in Masatoshi is there disclosed the desirability or necessity to include a tie layer at any position in their laminate. Further, during coextrusion persons of ordinary skill would not know whether to position the tie layer between the textile and outer film, or between the textile and the adhesive. Where would the enhanced bonding be required?

Capik provides absolutely no guidance in this regard because Capik discloses a laminate having any only an elastomeric core layer, and one or more polymeric skin (i.e., film) layers – no textile whatsoever. Capik, col. 2; lines 25-31. Further, Capik indicates that a tie layer is merely optional, and does not even exemplify its use in a single embodiment. Col. 6, lines 3-24.

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There is no teaching in either reference to indicate that it was known in the art that a coextruded polymer layer having a tie layer could reasonably be expected to be advantageously applied to a textile layer. Capik's laminate and method of coextrusion requires three layers, neither of which is a textile or nonwoven layer. Further, Capik does not disclose or suggest the desirability of combining his coextruded laminate with a textile or nonwoven layer, or fabric of any kind as there is no reference to nonwovens, textiles, etc. Therefore, there is no suggestion to combine the disclosures of Capik and Masatoshi. Accordingly, the combination of Masatoshi and Capik do not render the claims *prima facie* obviousness. MPEP § 2142.

Applicants respectfully remind Examiner that to maintain an obviousness rejection it is not sufficient to assert that Masatoshi's laminate may be able to physically incorporate selected aspects of Capik's or Abuto's laminate. It is required that the combination of references actually suggests the desirability of making it. MPEP § 2143.01. In view of the important features that distinguish Masatoshi's and Capik's disclosures, their combined teachings cannot fairly be viewed as suggesting newly amended claim 1.

In order to approximate the claims from Masatoshi, persons of ordinary skill in the art would have to perform the following mental steps:

1. Ignore the fact that Masatoshi's outer layer does not comprise a tie layer, nor does the reference disclose its desirability.
2. Ignore the fact that Capik does not disclose laminates having textile layers and adhesive layers.
3. Intuitively understand that the tie layer should be placed as in the Applicants' amended claim 1, and not, e.g., between the textile and the adhesive.
4. Ignore the fact that Capik suggests that tie layers are optional and perhaps unnecessary as evidenced by his lack of exemplifying such a laminate.

Applicants respectfully suggest that persons of ordinary skill would not perform such a mental process unless Applicants' claim were used as blue prints to reverse engineer the claimed laminate. Such hindsight reconstruction is clearly impermissible. See e.g., MPEP § 2141.

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In conclusion, newly amended claim 1 is not anticipated by Masatoshi, nor is it rendered obvious by Masatoshi combined with Capik. Respectfully, Abuto has no bearing on newly amended claim 1.

CONCLUSIONS

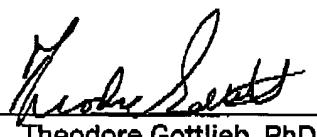
Applicants respectfully request that the prior art rejections be withdrawn and the claims be allowed in view of amended claim 1 and the foregoing remarks.

It is believed in good faith, that the claimed coextruded outer layer and its positioning in the claimed laminate is not taught or suggested by the combined references.

Therefore, allowance of the claims is respectfully solicited.

Respectfully Submitted,

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MARK UP OF AMENDED CLAIM

Claim 1 (Amended three times). Laminate composed of at least a first layer of an elastic polymer film and of a second layer of an elastic textile sheet, where the finished laminate has either a microembossed effect, a macroembossed effect, or both, -and

wherein a self-adhesive coating has been applied onto the textile sheet side.

and wherein the first layer is composed of two coextruded layers with an outer layer and a tie layer, where the tie layer is composed of pure thermoplastic polyolefins without addition of additives or colorants.